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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,799	03/25/2004	Barry J. Lipsky	P68/500578.20072	6031
26418	7590	09/29/2009		
REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT 599 LEXINGTON AVENUE, 29TH FLOOR NEW YORK, NY 10022-7650			EXAMINER TRUONG, THANHNGA B	
			ART UNIT 2438	PAPER NUMBER
			MAIL DATE 09/29/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/808,799

Applicant(s)

LIPSKY ET AL.

Examiner

THANHNGA B. TRUONG

Art Unit

2438

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 01, 2009 has been entered. Claims 18-31 are pending. Claims 1-17 are cancelled by the applicant. At this time, claims 18-31 are still rejected.

Response to Arguments

2. Applicant's arguments, with respect to claim 18-31 under **35 USC § 112**, filed on June 5, 2009 have been fully considered and are persuasive.

Applicant's arguments, with respect to claim 18-31 under **35 USC § 103**, filed on June 5, 2009 have been fully considered but they are not persuasive.

Applicant has argued that:

It is submitted that neither Mankoff, Cronce nor Schena, nor the combination thereof, disclose or suggest the features recited in amended claims 18 and 25. Specifically, none of the cited references disclose a hand held electronic reference product connected to a PC wherein an encrypted database file stored on the hand held product is accessed using the file system on the hand held product to provide for the decryption and display on the PC of information within the database file.

Examiner respectfully disagrees with the applicant and still maintains that:

Mankoff discloses PDA connected to client PC 10 as shown in Figure 2 for requesting and/or responding to given messages, and for extracting the data of interest. However Mankoff is silent on whether the data stored in the PDA is of secured or unsecured. On the other hand, Cronce discloses the portable authorization device connected to PC as shown in Figure 1, element 140 and element 110, and wherein Figure 1 is a diagram of an authorization system for selectively authorizing a host system to use a plurality of items of protected information (e.g., encrypted information/data) in accordance with a presently preferred embodiment of the invention,

including a portable authorization device, a host system and multiple types of information authorities (column 3, line 65 through column 4, line 4 of Cronce). In addition, Figure 1 of Cronce illustrates an authorization system 100 in accordance with a presently preferred embodiment of the invention. The authorization system 100 comprises one or more access control programs 117 associated with a host system 110, a portable authorization device 140, and one or more information authorities 160, 180 and 185. The authorization system 100 selectively authorizes the host system 110 to use a plurality of items of protected information 115 associated with the host system (column 4, lines 56-64 of Cronce). Besides, in view of the shortcomings of the above-described techniques, it is an object of the invention to provide an authorization device for authorizing the use of protected information that can be updated with new authorization information and yet is removably couplable to host devices, readily portable and relatively inexpensive. A second object of the invention is to provide a portable authorization device that can receive and store authorization information from multiple types of information authorities. A third object of **the invention is to provide a portable authorization device that offers a high level of security to prevent unauthorized access to the authorization information when stored or being transmitted** (emphasis added) (column 3, lines 28-40 of Cronce).

Applicant further argues that:

Cronce, however, does not disclose or suggest using the file system of the portable authorization device, rather than the file system of the host system, to access either the authorization information on the portable device or the protected information on the host system. Hence, Cronce does not disclose the various features of the present invention as recited in amended claims 18 and 25.

Examiner again respectfully disagrees with the applicant and still maintains that:

As mention above, Cronce does disclose a portable authorization device as show in Figure 1. Furthermore, in view of the shortcomings of the above-described techniques, it is an object of the invention to provide an authorization device for authorizing the use of protected information that can be updated with new authorization

information and yet is removably couplable to host devices, readily portable and relatively inexpensive. A second object of the invention is to provide a portable authorization device that can receive and store authorization information from multiple types of information authorities. A third object of **the invention is to provide a portable authorization device that offers a high level of security to prevent unauthorized access to the authorization information when stored or being transmitted** (emphasis added) (column 3, lines 28-40 of Cronce).

Thus, the combination of teaching between Mankoff and Cronce teaches the claimed subject matter. Cronce alone teaches/discloses a hand held electronic reference product connected to a PC wherein an encrypted database file stored on the hand held product is accessed using the file system on the hand held product to provide for the decryption and display on the PC of information within the database file.

Therefore, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, according to the above description and explanation, the combination of teaching between Mankoff and Cronce teaches the claimed subject matter. Thus, the teaching between Mankoff and Cronce are efficient and properly combined.

In response to applicant's arguments, the recitation "a hand held electronic reference product connected to a PC wherein an encrypted database file stored on the hand held product is accessed using the file system on the hand held product to provide for the decryption and display on the PC of information within the database file" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the

claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The fact that Examiner may not have specifically responded to any particular arguments made by Applicant and Applicant's Representative, should not be construed as indicating Examiner's agreement therewith.

For the above reasons, it is believed that the rejections should be sustained.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 18-20, 24-27, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff (US 2002/0116271 A1), and further in view of Cronic (US 7,032,240 B1).

a. *Referring to claims 18:*

i. Mankoff teaches in a system for coupling a hand held electronic reference product having an encrypted database file and a file system to a PC having a reader so that the PC can process the database file (see Figures 1-2 of Mankoff), the security validation subsystem comprising:

(1) a serial identification number for one of said hand held product and said file system (**paragraph [0032] of Mankoff**),

(2) a first voucher in said database file, said first voucher based on said serial identification number (**paragraph [0032] of Mankoff**), and

(3) a second voucher in said product at a location outside of said database file, said second voucher based on said serial identification number **(paragraph [0032] of Mankoff),**

(4) a comparator program within the PC reader to read and compare said first and second vouchers to provide a validation signal if said vouchers meet a predetermined correspondence comparison criterion **(paragraph [0032] Mankoff),**

(5) said validation signal permitting decryption (e.g., encryption scheme) by the PC of said database file **(paragraph [0032] of Mankoff),** wherein said database file is accessed using said file system of the handheld electronic reference product while said hand held electronic reference product is connected to said PC and thereby said file system maintaining control over the transmission of said database file **(see Figure 2 and paragraph [0023, 0026-0027] of Mankoff).**

ii. Although Mankoff teaches the system for coupling a hand held electronic reference product having an encrypted database file and a file system to a PC having a reader so that the PC can process the database file (see Figures 1-2 of Mankoff), Mankoff is silent on the capability of showing the PDA or handheld device included a serial identification number (if indeed is not inherent) and a hand held electronic reference product having an encrypted database file and a file system to a PC having a reader so that the PC can process the database file. On the other hand, Cronce teaches this limitation in **column 11, lines 35-38; column 3, lines 28-40; column 4, lines 56-64 of Cronce.**

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the invention of Mankoff with the teaching of Cronce for authorizing the use of protected information and, in particular, to a portable authorization device (commonly known as a "dongle") for authorizing a host system to use protected information **(column 1, lines 15-19 of Cronce).**

iv. The ordinary skilled person would have been motivated to:

(1) have modified the invention of Mankoff with the teaching of Cronic to provide a portable authorization device that offers a high level of security to prevent unauthorized access to the authorization information when stored or being transmitted (**column 3, lines 37-40 of Cronic**).

b. Referring to claim 19:

i. Mankoff further teaches:

(1) said vouchers are based on a serial number in said file system (**paragraph [0032] of Mankoff**).

c. Referring to claim 20:

i. The combination of teaching between Mankoff and Cronic teaches the claimed subject matter. Mankoff and Cronic further teaches:

(1) said vouchers are based on a serial number of said hand held product (**paragraph [0032] of Mankoff and column 11, lines 35-38 of Cronic**).

d. Referring to claim 24:

i. Mankoff further teaches:

(1) said predetermined criterion is identity between said vouchers (**paragraph [0032] of Mankoff**).

e. Referring to claims 25-27 and 31:

i. These claims consist the security validation method of providing access by a PC to an encrypted database file stored in a hand held electronic reference product, said hand held electronic reference product having a file system to implement claims 18-20 and 24, thus they are rejected with the same rationale applied against claim 18-20 and 24 above.

5. Claims 21-23, 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff (US 2002/0116271 A1) as applied to claims 18 - 20 and 24 above, in view of Cronic (US 7.032,240 B1), and further in view of Kobayashi (US 6,708,182 B1).

a. Referring to claims 21-23, 28-30:

i. Although the combination of teaching between Mankoff and Cronce teaches the claimed subject matter, they are silent on the capability of including the voucher (e.g. message format) in the header field. On the other hand, Kobayashi teaches this limitation in **column 2, line 57 through column 3, line 14 of Kobayashi**.

ii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the modified-invention of Mankoff with the teaching of Kobayashi to provide a portable electronic apparatus and message processing method which can decode a plurality of message format (**column 1, lines 35-37 of Kobayashi**).

iii. The ordinary skilled person would have been motivated to:

(1) have modified the modified-invention of Mankoff with the teaching of Kobayashi to enhance the data that contains in the header field.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 571-272-3858.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Taghi Arani can be reached at 571-272-3787. The fax and phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

/Thanhnga B. Truong/
Primary Examiner, Art Unit 2438

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TBT

September 22, 2009